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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/517,051	06/02/2005	John Francis Dufort	001058-00025	4299
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BLANK ROME LLP				
600 NEW HAMPSHIRE AVENUE, N.W.				
WASHINGTON, DC 20037				
EXAMINER				
HYLINSKI, ALYSSA MARIE				
ART UNIT		PAPER NUMBER		
3711				
MAIL DATE		DELIVERY MODE		
03/05/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/517,051

Applicant(s)

DUFORT, JOHN FRANCIS

Examiner

Alyssa M. Hylinski

Art Unit

3711

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 January 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 7, 8, 10-17, 20, 21, 23, 24, 26, 29, 30 and 33-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 7, 8, 10-17, 20, 21, 23, 24, 26, 29, 30 and 33-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/7/08 has been entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 10,11 and 33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Both claims 10 and 11 are dependent upon cancelled claim 9, making it unclear what limitations are meant to be encompassed by the claims. The examiner notes that these claims will be interpreted as being dependent on independent claim 1 for the purposes of this office action. Claim 33 is dependent on cancelled claim 32, making it unclear what limitations are meant to be encompassed by the claim. The examiner notes that this claim will be interpreted as being dependent on independent claim 29 for the purposes of this office action.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-2 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Wershe (6062111). Wershe discloses a device having a unitary one-piece body (12) and a stem with at least one transverse arm portion (18) that is movable between a first position in which the stem lies in a recess (27 & 28) in the body that is substantially parallel to a main or longitudinal axis of the body (Fig. 1) and a second position in which the stem extends through a central opening (32) formed in the body in a direction generally perpendicular to the main axis of the body (Fig. 7). The recess (27 & 28) extends through substantially the entire body in a direction substantially parallel to the main axis (Figs. 1 & 2). The body has an outer perimeter that is substantially continuous (Fig. 6). The stem is separable from the body (Fig. 2). In regard to the device being disclosed as a spinning top, the examiner notes that such a limitation is merely a recitation of the intended use of the device and as such need only be capable of performing the intended use to meet the claim. In this case the device of Wershe could be spun like a top.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-2, 7-8, 10-11, 20-21, 23-24, 26 and 33 are rejected under 35 U.S.C.

103(a) as being unpatentable over Pfister (DE 10013829 A1). Pfister discloses a spinning top and jewelry assembly having a body with a substantially continuous outer perimeter (12) and a stem (11). The stem is movable between a first position where the stem is received within a recess opening in the body such that it is substantially parallel to a main axis of the body (Fig. 1A) and a second position in which the stem extends through the recess opening formed in the body such that it extends in a direction that is perpendicular to the main axis of the body (Fig. 1B). The recess opening extends across substantially the entire body in a direction substantially parallel to the main axis (Fig. 1C). The stem has first and second transverse arm portions formed by pivot pins (119) protruding from its sides that engage holes or recesses (14) in the body to pivotally mount the stem to the body (Figs. 1A & 1B). A profile or outline of the stem varies along the length of the stem and is non-circular with a larger cross-sectional area halfway along its length formed by a bulbous portion (Fig. 1D). The stem has a pointed tip (114) and a handle portion (112). The body is a substantially planar circular disk (Fig. 1B). In regard to the body being a unitary one-piece member, the examiner notes that it would have been obvious to one of ordinary skill in the art to use a one piece construction as opposed to the segmented body shown by Pfister, since such a modification would have merely been a matter of obvious design choice. *See in re Larson*, 340 F.2d 965, 968, 144 USPQ 347, 349 (CCPA 1965).

8. Claims 12-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pfister and Heidenreich (1139119). Pfister discloses the basic inventive concept, substantially as claimed, with the exception of an outer element. Heidenreich discloses a circular disk shaped piece of paper with a center hole that functions as an outer element attaching to and extending over a majority of a top part of a body and partially secured by a flange on the body of the toy (page 1 lines 47-53). It would have been obvious to one of ordinary skill in the art from the teaching of Heidenreich to include the outer element in order to incorporate advertising matter onto the toy. The outer element being removably mounted to the top and bottom of the body would have been an obvious matter of design choice to a person of ordinary skill in the art because Applicant has not disclosed that having the outer covering being removable from both the top and bottom of the body provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the covering being permanently adhered to just the top of the body because it would allow an advertisement to be easily seen and prevent a person from removing the advertisement at a later time. In regard to the outer element being made of resilient material, examiner notes that the mere selection of known materials as recited in claim 17, on the basis of suitability for the intended use would be entirely obvious. See in re Leshin, 125 USPQ 416 (CCPA 1960). Therefore, it would have been obvious to one of ordinary skill in the art to provide Heidenreich with resilient material in order to use a known material suitable for the intended use.

9. Claims 29 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pfister and Ebara (5787731). Pfister discloses the basic inventive concept, substantially as claimed, with the exception of first and second latching members extending from the stem and body respectively. Ebara discloses a jewelry element having a rotatable stem member (4) with a latch member (17) in the form of tabs (Fig. 7) that abut against a latch member (Fig. 5) in the form of a tab (11) of the body of the member (Fig. 4) so as to prevent rotation of the stem with respect to the body. It would have been obvious to one of ordinary skill in the art to utilize the locking element of Ebara in order to achieve the predictable result of preventing rotation of the elements.

10. Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pfister. Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pfister and Ebara. The references disclose the basic inventive concept, substantially as claimed with the exception of the transverse arm portion extending from the center of the stem. At the time the invention was made it would have been an obvious matter of design choice to have the arm portion at a center location since Applicant has not disclosed that placing the arm portion at a center location provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the arm portion not being positioned at a center location since it still allows for the stem member to be rotated relative to the body so as to form a top member.

Response to Arguments

11. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alyssa M. Hylinski whose telephone number is 571-272-2684. The examiner can normally be reached on M-F (8-5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eugene Kim can be reached on 571-272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AMH

/Gene Kim/

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Supervisory Patent Examiner, Art Unit 3711